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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/900,512	07/06/2001	Richard Norris Dodge II	11710-0112	3910

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7590 06/19/2003

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EXAMINER	
PIERCE, JEREMY R	
ART UNIT	**PAPER NUMBER**
1771	

DATE MAILED: 06/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/900,512	DODGE ET AL.
	Examin r	Art Unit
	Jeremy R. Pierce	1771

-- The MAILING DATE of this communication appears on th cover she t with th correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 May 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-47* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-47* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 102/103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1-47 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Mukaida et al. (U.S. Patent No. 5,676,660) as set forth in section 4 of the last Office Action.

3. Claims 1-47 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Goldman et al. (U.S. Patent No. 5,669,894) as set forth in section 5 of the last Office Action.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-47 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 and 31-39 of copending Application No. 09/475,830. Although the conflicting claims are not identical, they are not patentably distinct from each other because the same structural limitations are present in the claims and similar property claims are present. The additional limitation of composite permeability and intake rate meeting certain equations in the present application would be inherent or obvious to provide over the claims of the 09/475,830 application, for the same reasons set forth in the prior art rejections.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

6. Applicant's arguments filed in Paper No. 7 have been fully considered but they are not persuasive.

7. Applicant argues that the superabsorbent materials of Applicants' invention and Goldman's invention are at opposite ends of the capacity spectrum, and would thus have very different intake rates and composite permeability. However, the Goldman reference uses the same material (i.e. polyacrylate as the superabsorbent) as Applicant, so the properties of the superabsorbent material would be similar.

8. Applicant argues that Goldman teaches high capacity superabsorbents and therefore could not inherently possess the fluid properties of Applicant's claimed composite. However, the Goldman reference uses the same material (i.e. polyacrylate

as the superabsorbent) as Applicant, so the properties of the superabsorbent material would be similar.

9. Applicant argues that although the capacity values of the Goldman reference appears to overlap with the capacity values of the present invention, they actually do not because the values are calculated under different pressures. Applicant then uses U.S. Patent No. 5,601,542 to show that capacity values decrease when pressure increases. Applicant calculates an average drop of 2.5 g/g in capacity over the range of 0.6 psi to 0.7 psi to determine that the material of Goldman would land outside of the claimed range. However, this reasoning fails to overcome the rejection. First, the proposed calculation of a 2.5 g/g average drop in capacity is without base because no measurements were taken in the Melius et al. reference at either 0.6 psi or 0.7 psi. Also, it is not said whether the materials used in Melius et al. are the same as those used by Applicant or Goldman et al. Comparison values need to be taken on the materials disclosed by Goldman et al. for a direct comparison.

10. Applicant argues that the absorbent products of Mukaida require high capacities water-absorbent resins. However, the Mukaida reference uses the same material (i.e. polyacrylate as the superabsorbent) as Applicant, so the properties of the superabsorbent material would be similar.

11. Applicant argues that Mukaida teaches lower intake rates than Applicant. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., intake rate) are not recited in the rejected claim(s). Although the claims are interpreted in light

of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

12. Applicant tests Sanyo AD-890 and shows that it fits the characteristics of the absorbent resin disclosed in Mukaida, and is a good representative of the high capacity absorbent resins disclosed by Mukaida. Applicant then compares Sanyo AD-890 to the present invention to show how they differ. However, Applicant cannot prove the Mukaida reference does not meet the claimed property limitations by showing that some material, which is similar to an absorbent resin in Mukaida, fails to meet the claimed limitations. Applicant's showing must be commensurate in scope with the Mukaida reference. Applicant must show that all the materials disclosed by Mukaida in all the embodiments disclosed by Mukaida would fail to meet the claimed limitations. Applicant has failed to do this.

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeremy R. Pierce whose telephone number is (703) 605-4243. The examiner can normally be reached on Monday-Thursday 7-4:30 and alternate Fridays 7-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Jeremy R. Pierce
Examiner
Art Unit 1771

June 16, 2003

ELIZABETH M. COLE
PRIMARY EXAMINER